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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,716	02/12/2004	Susann Marie Keohane	AUS920040032US1	5925
35525	7590	10/19/2006	EXAMINER	
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,716

Applicant(s)

KEOHANE ET AL

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Action Background***

1. This action is responsive to the applicant's amendment, filed on 7/27/2006.
2. Applicant has amended claims 1, 5-7, 11-15 and 17-19.
3. Claims 1-20 are pending in the case, claims 1, 7, 13 and 19 are independent claims.
4. Examiner's rejection of claims 1-6 and 13-20, made under 35 USC 101 in the *Claim Rejections – 35 USC 101* section of the previous office action (dated 4/28/2006) is withdrawn in view of applicant's remarks.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*
6. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. **Regarding claims 1, 7, 13 and 19**, the amendment filed 7/27/2006 adds the following limitation: *"wherein the word processing document is not a spreadsheet"*. The examiner has reviewed the originally filed specification, and has failed to find support for the added limitations. Applicant is required to cancel the new matter in response to this office action.
8. **Regarding claims 2-6, 8-12, 14-18 and 20**, the claims are rejected for fully incorporating the deficiencies of the base claims.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:  
  
*"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*
10. Claims 7-12 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
11. **Regarding Claims 7-12**, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of § 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such

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they fail to fall within a statutory category. They are, at best, functional descriptive material, *per se*.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."*

13. Claims 1-5, 7-11, 13-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Microsoft Excel 2000, copyright 1999 by Microsoft Corporation (hereinafter Excel). The examiner has provided screen snapshots of the Excel spreadsheet program in support of the rejection described herein.

14. **Regarding independent claim 1**, Excel discloses modifying a document in a data processing environment. Applicant's disclosure indicates that applicant's definition of a document includes documents generated by programs including word processors, spreadsheet programs, web design programs, and publishing programs (page 1, second and third paragraphs of the originally filed specification). Excel is well known as a spreadsheet

program that provides for the generation and modification of spreadsheet documents.

Excel allows a user to select a first portion of content within a document for deletion. Excel can determine whether the selected content is protected from deletion. Excel can prevent the deletion of the content. Figure 2 of Excel shows a spreadsheet. Figure 3 of Excel shows a user selection of spreadsheet cell C5. The user has selected the Delete key from the keyboard (not shown). Excel has responded to the delete request by the message shown in Figure 4 indicating that the cell is protected and cannot be modified. Excel has prevented the deletion of the content.

15. **Regarding dependent claim 2**, Excel discloses receiving a second user input that allows the deletion of the content. Excel's Figure 5 discloses a password entry box in which a user would enter a password that would allow the content to be deleted. In Figure 6, Excel discloses the content as being deleted (the data in cell C5 is gone).
16. **Regarding dependent claim 3**, Excel discloses an indication that the selected content is protected content in Figure 4.
17. **Regarding dependent claim 4**, Excel discloses an indication as highlighting the content as shown in Figure 3, wherein cell C5 is shown with highlighted (highlighting is indicated by a border around the cell).

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18. **Regarding dependent claim 5**, Excel discloses the content as text.

Although the example shows the protection of the numeric values in the document, the text values (row headings) are equally protected.

19. **Regarding claims 7-11**, the claims are directed to a system for the method of claims 1-5, and are rejected using the same rationale.

20. **Regarding claims 13-17**, the claims are directed to computer readable media for the method of claims 1-5, and are rejected using the same rationale.

21. **Regarding claims 19 and 20**, the claims are directed to a system for the method of claims 1 and 2, and are rejected using the same rationale.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

23. Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Excel.

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24. **Regarding dependent claim 6**, Excel discloses the use of a filter in Figure 7, however Excel fails to disclose the use of a grep Filter. However, applicant's disclosure describes a grep filter as: "*A grep filter searches line by line for a specific pattern and outputs any line that matches the pattern*" (page 13, second paragraph of the originally filed specification). Excel discloses in Figure 7, an advanced filter that filters the list in place, within a specified range in a sequential manner. So although Excel fails to explicitly describe a grep filter, Excel's filter is obviously performing the same function.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to use the filtering functions of Excel as a grep filter in order to sequential review specific data.

25. **Regarding claims 12 and 18**, the claims are directed toward a system and a computer readable media, respectively, for the method of claim 6, and are rejected using the same rationale.



***Response to Arguments***

26. Applicant's arguments filed 7/27/2006 have been fully considered but they are not persuasive.
27. Regarding claims 7-12, the claims remain rejected under 35 USC 101 as stated above. Although claims 7-12 are directed toward a data processing system, the claims lack the necessary physical articles to constitute a machine or manufacture within the meaning of section 101.
28. Regarding claim 1, Applicant indicates that the amendment filed 7/27/2006 overcome the cited reference (see page 10, third paragraph). However, the examiner has reviewed the originally filed specification has not found support for the amendment. Applicant's originally filed specification indicates that a document (as originally claimed) includes spreadsheets (see page 1, second and third paragraphs of the originally filed specification). Applicant is directed to cancel the new matter.

***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
Patent Examiner  
October 13, 2006



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER